

Remarks

Claims 1-43 are pending in this application. By this Amendment claims 2-8, 10-23, 25, 27-33 and 35-43 have been amended to bring the claims into conformity with U.S. practice, and correct grammatical errors. Claim 15 has been amended to include an omitted word. Support for the amendment of claim 15 can be found in the claims as originally filed.

No new matter is introduced by the foregoing amendments. After entry of this Amendment, **claims 1-43 are pending in this application**. Substantive examination of the pending claims is requested.

Response to Restriction Requirement

Claims 1-43 are subject to a restriction requirement under 35 U.S.C. §121 and §372. The Office has divided the claims into groups I-VIII (although only groups I, II, III, VI, VII and VIII are listed). Applicants hereby elect the claims of **Group I (claims 1-14, 18-23, and 28-33)** for prosecution in the subject application with traverse for at least the following reasons.

The Office alleges that the claims “do not relate to a general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features The expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art” (Office action, pages 2-3). To support the assertion that the pending claims lack a unifying special technical feature, the Office cites Weller *et al.*, *Science*, 297:1686-1689, 2002. However, as discussed below, Weller *et al.* cannot be used as prior art against this application.

MPEP §2132.01 states: “where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference . . . by submission of a specific declaration by the applicant establishing that the article is describing applicant’s own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)”.

Submitted herewith is a Declaration by Aidan J. Doherty, Marina Della, Geoffrey R. Weller, and Stephen P. Jackson, the Inventors of the subject application. As of this filing, Marina Della was unavailable to sign the Declaration; Applicants will submit a fully-signed Declaration once Dr. Della is available.

As indicated in the Declaration, any subject matter of the claimed invention that is described in Weller *et al.* is the work of the Inventors alone, notwithstanding the presence of other co-authors on the reference, who worked under the direction of the Inventors. Thus, under the guidelines stated in MPEP §2132.01, Exhibit A demonstrates that Weller *et al.* merely describes the Inventors' own work and not that "by another".

Moreover, Weller *et al.* is not prior art under 35 U.S.C. §102(b). As quoted in MPEP §2133.02, "Any invention described in a printed publication more than one year prior to the date of a patent application is prior art under Section 102(b), even if the printed publication was authored by the patent applicant. *De Graffenreid v. United States*, 16 USPQ2d 1321, 1330 n.7 (Cl. Ct. 1990)". Weller *et al.* was published on September 6, 2002, which is less than one year before the August 12, 2003 priority date of the subject Application. Thus, Weller *et al.* is not prior art under 35 U.S.C. §102(b).

Having established that Weller *et al.* is the Inventors' own work and that it is not prior art under 35 U.S.C. §102(b), Applicants submit that Weller *et al.* is not available as a reference to show that the pending claims lack a unifying special technical feature. As stated by the Office, a unifying special technical feature of Applicants' pending claims is methods of modifying a nucleic acid comprising contacting the nucleic acid molecule with a prokaryotic DNA repair ligases. Without Weller *et al.*, the Office has neither allegation nor evidence that these methods were disclosed or rendered obvious by the prior art, and therefore Applicants' claims clearly contain an appropriate "corresponding special technical feature" sufficient for fulfilling the unity of invention requirement (*See* 37 CFR § 1.475(a); MPEP § 1893.03(d)).

As required by 37 CFR § 1.475, the claims pending in the application have unity of invention because they are directed "to a group of inventions so linked as to form a single

general inventive concept" because "there is a technical relationship among [the] inventions involving one . . . corresponding technical feature[]]" and this special technical feature "define[s] a contribution . . . over the prior art." In the present case, a corresponding technical feature that links the claims into a single general inventive concept is methods of using prokaryotic DNA repair ligases that are described in the subject application. Because the claimed are linked by the unifying technical feature which is not taught by the prior art, unity of invention exists among all of the alleged Groups in the present application. Thus, it is inappropriate to subject the claims to a requirement for restriction. Applicants request that the requirement be withdrawn, that all of Groups I through VIII be rejoined, and that all of the claims be examined in the current case.

In accord with 37 CFR §1.143, Applicants specifically reserve the right to petition to have the appropriateness of the finding of lack of unity/restriction requirement reconsidered, if it is maintained in spite of this response.

Conclusion

Based on the foregoing Amendment, the claims are in condition for substantive examination. If any issues remain to be addressed prior to examination, the Examiner is invited to telephone the undersigned at the telephone number listed below.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By _____ /Tanya M. Harding/
Tanya M. Harding, Ph.D.
Registration No. 42,630